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| 10/772,100 | 02/04/2004 | Jeffrey Ying | 156886-0061 | 4867 |
| 29000 7590 02/22/2010 IRELL & MANELLA LLP 1800 AVENUE OF THE STARS SUITE 900 LOS ANGELES, CA 90067 | | | | |
| EXAMINER | | | | |
| ADE, OGER GARCIA | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/772,100

Applicant(s)

YING, JEFFREY

Examiner

GARCIA ADE

Art Unit

3687

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-85 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-85 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on **12/23/2009** has been entered.

Response to Amendment

2. The amendment filed on **12/23/2009** has been considered. Applicant amended **claim 63**. **Claims 63-85** are pending.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 63 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had

possession of the claimed invention. For example: The newly added limitations "without action by the user ... and monitoring cellular radio frequencies ... were not described in the specification.

5. Claims 63-85 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement, based on their dependency on claim 63.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 63-65, and 70-85** are rejected under 35 U.S.C. 102(e) as being anticipated by Khan et al. [US 2004/0029569 A1].

As per claims 63, 64, 70, 76-80, 82-85, Khan discloses a method for carrying out consumer transactions at a point-of-sale establishment, comprising the steps of:

automatically detecting, at a local wireless station affiliated with a point-of-sale system, the transient physical presence of a wireless cellular device within proximity of the wireless station, without action by the user of the mobile wireless cellular device, by monitoring cellular radio frequencies utilized by the mobile wireless cellular device [see

at least the abstract and paragraphs 48 and 30 (e.g. *cell phones, personal digital assistants, RF proximity chip cards, and laptop personal computers*)];

in response to detecting the specific wireless cellular device, automatically initiating targeted radio frequency (RF) communication from the point-of-sale system [as illustrated in figure 1] addressed to the specific detected wireless cellular device via the local wireless station; **[see at least the abstract and paragraph 32 (e.g. *the buyer's PTD can initiate the transaction*)**];

receiving at the point-of-sale system, via the local wireless station, a user response entered at the wireless cellular device **[see at least paragraph 36, via step 1206]**;

automatically conveying a menu of user options to the wireless cellular device via the local wireless station **[see at least paragraph 14 (e.g. *purchase option to a buyer's personal trusted device (PTD) using a wireless protocol*)**];

receiving and storing, at said point-of-sale system, user selections transmitted from the wireless cellular device via the local wireless station **[see at least paragraph 33 (e.g. *the buyer selects a presented option and the PTD transmits a corresponding purchase request signal to short range transceiver 304*)**]; and

determining a point-of-sale transaction price based upon said user selections **[see at least paragraph 34 (e.g. *the price of the purchased services*)**].

As per claim 65, Khan discloses the steps of: sending, from said point-of-sale system, a request for point-of-sale transaction approval to a remote processing center, said point-of-sale transaction approval including said transaction price **[see at least**

paragraph 14 (e.g. *An approval request is generated from the purchase request*),
and paragraph 36 (e.g. *this purchase approval request includes order and purchase component information*));

receiving, at said point-of-sale system, a point-of-sale transaction approval response from said remote processing center [**see at least paragraph 36** (e.g. *a purchase approval request to a transaction authorizer located in a remote location*)]; and

displaying an indication of the point-of-sale transaction approval response on a point-of-sale terminal affiliated with said point-of-sale system [**see at least paragraphs 89 and 100** (e.g. *display 334*)].

As per claim 71, Khan discloses said remote processing center uses a password entered by the user via said wireless cellular device in connection with authentication [**see at least paragraph 71** (e.g. *password generation*)].

As per claim 72, Khan discloses said local wireless station comprises a short-range wireless transceiver covering a microcellular region overlapping with the coverage area of a separate cellular network with which the wireless cellular device is registered [**see at least paragraph 32** (e.g. *mixture of transceiver signals*)]

As per claim 73, Khan discloses said local wireless station automatically detects the transient presence of said wireless cellular device by [**see at least the abstract and paragraphs 48 and 30** (e.g. *cell phones, personal digital assistants, RF proximity chip cards, and laptop personal computers*)];

- monitoring one or more frequencies and/or channels utilized by a base station of the cellular network, said base station having a coverage area overlapping said microcellular region [see at least paragraphs 58 and 63]; and

- detecting communications between the wireless cellular device and said base station on said frequencies and/or channels [see at least paragraphs 12 and 13].

As per claims 74 and 75, Khan discloses said local wireless station automatically detects the transient presence of the wireless cellular device by receiving a message from said cellular network that the wireless cellular device is within or nearby said microcellular region [see at least paragraphs 57, 70, 76, 105 and 109].

As per claim 81, Khan discloses said items selectable for purchase include a plurality of food items, said food items being physically available at the point-of-sale establishment associated with said point-of-sale terminal [see at least paragraphs 3 and 73] .

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. **Claims 66-69** are rejected under 35 U.S.C. 103(a) as being unpatentable over Khan, and further in view of Stadelmann [US 6,415,156].

As per claims 66-69, Khan discloses said remote processing center authenticates the user or wireless cellular device before approving the point-of-sale transaction [**see at least paragraph 15, 35, and 63**], and the step of adding additional funds to the user account maintained at the remote processing center through a user-initiated electronic transfer [**see at least paragraphs 69, 86**].

Khan discloses all elements per claimed as explained above. Khan does not explicitly disclose said remote processing center automatically deducts the transaction price from the user's account upon approval of the point-of-sale transaction, said remote processing center includes a user account from which a user may automatically draw funds for purchasing goods or services offered through the point-of-sale establishment, and the step of adding additional funds to the user account maintained at the remote processing center through a user-initiated electronic transfer.

However, Stadelmann discloses said remote processing center automatically deducts the transaction price from the user's account upon approval of the point-of-sale transaction [**see at least the abstract**], said remote processing center includes a user

account from which a user may automatically draw funds for purchasing goods or services offered through the point-of-sale establishment [see at least column 3: lines 47-62].

Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to incorporate the teaching of Stadelmann to the teaching of Khan in order to provide a method of ordering and paying for goods or services with a mobile radio telephone, in particular with a GSM (Global System for Mobile Communications) or UMTS (Universal Mobile Telephone System) mobile radio telephone [see summary of the invention].

Response to Arguments

11. Applicant's arguments filed **10.28.2009** have been fully considered but they are not persuasive.

Applicant argues that the reference Khan does not disclose " automatically detecting, at a local wireless station affiliated with a point-of-sale system, the transient physical presence of a specific mobile wireless cellular device within proximity of the wireless station, without action by the user of the mobile wireless cellular device, by monitoring cellular radio frequencies utilized by the mobile wireless cellular device". The Examiner respectfully disagrees. Khan discloses in paragraph 63 a automatically detects the transient presence of the mobile wireless cellular device by "monitoring one or more frequencies and/or channels utilized by a base station of the cellular network, said base station having a coverage area overlapping said microcellular region," and

"detecting communications between the wireless cellular device and said base station on said frequencies and/or channels". Figure 10 of Khan is a simplified component diagram of physical devices and systems utilized to implement an embodiment of an adaptor.

Applicant further argues that respectfully submitted that Kahn does not disclose any method for "automatic detection of the presence of a mobile wireless cellular device". The Examiner respectfully disagrees. Khan discloses in claim 19 an unmanned station configured to automatically dispense the product or service to the buyer (as illustrated in figure 3). In paragraph 121, Khan further discloses a ViVOserver, or PC-based ViVOWallet application with attached MicroAdapter, would detect the changes when the RF proximity card is presented to a MicroAdapter and communications are established.

The elements are all known but not combined as claimed. The technical ability exists to combine the elements as claimed and the results of the combination are predictable. When combined, the elements perform the same function as they did separately. The prior art differs from the claim by the substitution of some components. The substituted components were known. The technical ability existed to substitute the components as claimed and the result of the substitution is predictable.

Applicant's arguments having been found unpersuasive, the rejection has not been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARCIA ADE whose telephone number is (571)272-5586. The examiner can normally be reached on M-F 8:30AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571.272.3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Gart/
Supervisory Patent Examiner, Art Unit 3687

Garcia Ade
Examiner
Art Unit 3687